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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,532	12/08/2003	Jonathan D. Albert	INK-055C1	3008

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EXAMINER

FATAHI YAR, MAHMOUD

ART UNIT	PAPER NUMBER
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2629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/730,532

Applicant(s)

ALBERT ET AL.

Examiner

Mike Fatahiyar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, 10, 12-18 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-10, 12-18 and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Affidavits filed on 10/10/06 under 37 CFR 1.131 has been considered but is ineffective to overcome the Gelbman(6,924,781B1) reference.
2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Gelbman(6,924,781B1) reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Applicant fail to show possession of the entire claimed inventions:

In claims 1 and 27, Applicants fail to show "a data receiver in communication with said control system; a display in electrical communication with said data receiver; a plurality of cavities....."

In claim 2, Applicants fail to show a power source in communication with said display system.

In claim 3, Applicants fail to show a battery.

In claim 4, Applicants fail to show a solar cell.

In claims 5-7, Applicants fail to show the control circuitry, the driver circuitry and said data receiver are disposed on a substrate.

In claim 9, Applicant fail to show an electrically inactive display medium.

In claims 10 and 28, Applicant fail to show the control system is arranged to generate reports on the history and status of the data receiver.

In claims 12, 14 and 29, Applicant fail to show an Antenna.

In claim 13, Applicant fail to show the display is incorporated into an item of clothing.

In claim 15, Applicant fail to show the control system is a server.

In claim 16, Applicant fail to show a client in communication with the server.

In claim 17, Applicant fail to show a memory element storing a data base including authorization information associated with the client.

In claim 18, Applicant fail to show the control system having a schedule.

3. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Gelbman(6,924,781B1) reference to either a constructive reduction to practice or an actual reduction to practice. Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence. THE ENTIRE PERIOD DURING WHICH DILIGENCE IS REQUIRED MUST BE ACCOUNTED FOR BY EITHER AFFIRMATIVE ACTS OR ACCEPTABLE EXCUSES .

An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908,919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); In

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re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.). See MEPP 2138.06.

4. In Addition, applicant failing to show evidence of conception prior to the effective date of the Gelbman(6,924,781B1) reference for all the claims limitations, Applicant also has failed to establish diligence, See MPEP 2183.06. Whereby Applicant must show diligence for the entire period. A 2-day period lacking activity has been held to be fatal. Therefore, Examiner holds the previous claimed rejection, which is fully addressed below.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-7, 9-10, 12-18 and 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Gelbman (US006924781B1).

As to claim 1, Gelbman discloses a controlled display system comprising: discloses a control system (fig. 2(16)); a data receiver (fig.2 (22)); a display system (fig.2 (30)), wherein said display comprises: a substrate (inherent for e-ink to have a substrate); a plurality of cavities dispersed in a polymeric matrix; wherein at least one of said plurality of cavities contains an electrophoretic contrast medium phase that includes at least one particle and suspending fluid (see, fig.4 (42), col.8, lines 24-56); at least two electrodes disposed on said substrate adjacent to said at least one of said plurality of cavities and positioned in a spaced apart relationship to one another, wherein a potential difference between said electrodes causes the particle to migrate toward at least one of said at least two electrodes, thereby effecting change in visual state (see, col.8, lines 48- col.9, lines 14).

As to claims 2-4, Gelbman discloses a power source in connection with the display (power source is a battery, a solar cell) (see, col.10, lines 6-10).

As to claim 5, Gelbman also discloses a substrate supporting said display and said data receiver (fig.4 (30,48,50)), said data receiver comprising a series of chips disposed on said substrate (fig.4 (48,50)).

In regard to claim 6, Gelbman teaches a display (fig.4 (30)), it is inherent for Gelbman's driver circuitry to be disposed in a substrate).

As to claim 7, Gelbman discloses that the receiver (fig.4 (50)) is disposed in a substrate.

As to claim 9, Gelbman also teaches that an electrically inactive display (fig.4 (42)).

As to claims 10 and 28, Gelbman further teaches that said control system stores in a memory element a display log including at least one entry representing the past, present or future condition of a display (see, col.5, lines 36-42, 58- col. 6, lines 44 (as best understood)).

In regard to claims 12, 14 and 29, Gelbman further teaches an antenna (fig.4 (48)). As to claim 13, the display is incorporated into an item of clothing as taught by Gelbman (col.21, lines 29-46).

6. Applicant's arguments filed 10/10/07 have been fully considered but they are not persuasive. The submitted Affidavits is ineffective to overcome the Gelbman reference.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Fatahiyar whose telephone number is (571)272-7688. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF
M. FATAHIYAR

February 19, 2007



RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
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